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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,627	04/10/2007	Robert A. Hansen	930022-2048.0.14.US	3948
7590 Ronald R. Santucci Frommer Lawrence & Haug 745 Fifth Avenue New York, NY 10151				
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EXAMINER				
HUG, ERIC J				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,627

Applicant(s)

HANSEN, ROBERT A.

Examiner

Eric Hug

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006 and 10 April 2007.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 05 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 6/5/06, 4/10/07, 4/2/08
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites "said first color is only visible in ultraviolet light" (emphasis added). Although a color difference between batt layers may be visible only in ultraviolet light, the first batt layer will have a first color in any type of light.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Lundstrom (US 4,500,588).

Lundstrom discloses in Figure 3 a papermaking press fabric comprising a woven base fabric 1, a coarse-fibered batt layer 22B, a fine-fibered batt layer 22A, and a non-woven fabric 24 inserted between the batt layer 22A and 22B. See column 4, lines 14-21. These features read respectively on the base fabric, the first and second staple fiber batt materials, and the fine fabric of claims 1 and 6. Thus, Lundstrom discloses the structure of the claimed press fabric.

Lundstrom does not disclose that the coarser first batt layer (22B) and finer second batt layer (22A) have different colors. However, by virtue of their different fiber fineness (6 denier for the first batt layer, 3.74 denier for the second batt layer; see column 4, lines 39-42), it is deemed that the two layers inherently have a different color. Fibers of different size will reflect light differently, appearing as different colors (even if ever so slight). The color difference should show in ultraviolet light as well as visible light.

Because the fabric of Lundstrom structurally is the same as the claimed press fabric, Lundstrom anticipates the claims. Any recitation of using the color differential of the batt layers to indicate wear is merely an intended manner of using the fabric.

A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *Ex parte Masham*, 2 USPQ2d 1647. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Furthermore, the claims are unpatentable over Lundstrom, because the claimed color difference is considered to be merely an aesthetic difference. See *In re Takai*, 171 USPQ 558 (C.C.P.A. 1971), wherein the board affirmed, reasoning that structurally there are no real differences between the claimed fabric and one shown in the prior art, when the only difference was in regards to claimed color limitations. The board found these differences to be “only the application of ordinary artistic skill which would have been obvious under the provisions of 35 U.S.C. 103.”

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 7,407,564. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed stratified press fabric is structurally identical to the fabric claimed in US 7,407,564, differing only in the recitation of the color of one or more layers. The added element of color does not patentably distinguish the claims for the reasons set forth in *In re Takai* above. All other claimed features are encompassed by the claims of US 7,407,564 as follows:

Claims 1-5: All structural features pertaining to the base fabric, first batt layer, fine fabric, and second batt layer, including the first batt layer being coarser than the first batt layer, are claimed in claim 1 of US 7,407,564.

Claims 6, 11, and 17 correspond to claim 1 of US 7,407,564.

Claim 7 corresponds to claim 2 of US 7,407,564.

Claim 8 corresponds to claim 3 of US 7,407,564.

Claim 9 corresponds to claim 7 of US 7,407,564.

Claim 10 corresponds to claim 5 of US 7,407,564.

Claim 12 corresponds to claim 6 of US 7,407,564.

Claim 13 corresponds to claim 4 of US 7,407,564.

Claim 14 corresponds to claim 8 of US 7,407,564.

Claim 15 corresponds to claim 9 of US 7,407,564.

Claim 16 corresponds to claim 10 of US 7,407,564.

Claim 18 corresponds to claim 11 of US 7,407,564.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ito et al (JP 2003-049381) teaches using different colored elastic layers of a papermaking press belt. [This document was cited by Applicant in the IDS of June 5, 2006. A JPO machine translation of this document is provided herein.]

Draper (GB 2315499) teaches using color wear indicators in papermaking press felts. [This document was also cited by Applicant in the IDS of June 5, 2006.]

Shah (US 4,511,361) discloses a press fabric with a dye pattern for indicating alignment.

McGee (US 4,283,455) discloses a V-belt with different layer characteristics to indicate wear.

Blackburn et al (US 3,009,234) discloses a papermaking felt with colored guide lines.

Munch (US 2004/0129398) discloses a process for monitoring the condition of a papermaking belt, which may include the use of color indicators.

Martinsson et al (US 2004/0266296) discloses multi-layered filaments with layers of contrasting color.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Hug whose telephone number is (571) 272-1192. The examiner can normally be reached on Monday through Friday, 10:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric Hug/
Primary Examiner, Art Unit 1791